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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,892	08/29/2001	Eric D. Anderson	500247.03	2384

7590

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EXAMINER
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ENGLAND, DAVID E

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/943,892

Applicant(s)

ANDERSON, ERIC D.

Examiner

David E. England

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 30-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 02/14/2006 *EL*

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

*DL*

### **DETAILED ACTION**

1. Claims 30 – 36 are presented for examination.

#### ***Information Disclosure Statement***

2. The information disclosure statement filed 09/19/2003 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.
3. Applicant is asked to resubmit only the list of prior art for it is missing from our files.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 30, 31, 33, 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (6067561) in view of Arnold (6275848) and what is well known in the art.
6. Referencing claim 30, as closely interpreted by the Examiner, Dillon teaches a computer-implemented method for one of a plurality of designated recipients of an Email communication to receive the Email, comprising:
  7. receiving on a recipient's computer an Email communication notification from the server that references the single copy of the Email communication, the Email communication notification distinct from the Email communication, (e.g. col. 1, line 25 – col. 2, line 38 & col. 3, line 12 – 65);
  8. requesting from the server the referenced Email communication, the request being sent to the Email communication program from the recipient's computer system, (e.g. col. 1, line 25 – col. 2, line 38 & col. 3, line 12 – 65), but does not specifically teach providing an Email communication program on a server that is configured with instructions to store a single copy of the Email communication on the server if the Email communication is designated for the plurality of recipients;
  9. receiving by the recipient's computer system from the server, a copy of the requested Email communication.
10. Arnold teaches providing an Email communication program on a server that is configured with instructions to store a single copy of a section of the Email communication on the server if

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the Email communication is designated for the plurality of recipients, (e.g. col. 3, line 57 – col. 4, line 42);

11. receiving by the recipient's computer system from the server, a copy of the requested section of the Email communication, (e.g. col. 3, line 57 – col. 4, line 42). It would have been obvious to one skilled in the art at the time the invention was made to combine Arnold with Dillon because it would be more efficient to conserve space with having one central location, having users reference the single copy of the email then having multiple copies of an attachment taking up substantial space. Furthermore, it is more convenient for a user to have a local copy of an Email so incase the user is off line and wants to modify the local copy of the attachment, the user could with out modifying the original attachment that could be used as an archived document for reference if desired. Arnold does not specifically teach storing a single copy of an email message. It would have been obvious to one of ordinary skill in the art to store a single copy of an email instead of just an attachment since it is well known in the art that an email is nothing more than a message or document sent between users and it would only take one of ordinary skill in the art to, instead of storing a single copy of an attachment, which can also be considered a message, storing a single copy of an email utilizing the teachings of Arnold's criteria for storing a single copy of a message or document.

12. Referencing claim 31, as closely interpreted by the Examiner, Dillon does not specifically teach when access to the Email communication is no longer desired by the recipient, indicating to the Email communication program to delete the Email communication, so that the Email communication program deletes the single stored copy of the Email communication from the

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server after receiving indications from all recipients to delete the Email communication. Arnold teaches when access to the Email communication is no longer desired by the recipient, indicating to the Email communication program to delete the Email communication, so that the Email communication program deletes the single stored copy of the Email communication from the server after receiving indications from all recipients to delete the Email communication, (e.g. col. 4, line 25 – col. 5, line 25). It would have been obvious to one skilled in the art at the time the invention was made to combine Arnold with Dillon because of similar reasons stated above.

13. As per claim 33, Dillon does not specifically teach storing the Email communication locally by the recipient on the recipients computer system such that the local stored Email communication is preserved even when the Email communication program deletes the single stored copy of the Email communication from the server.

14. Official Notice is taken that it was a common practice to store the Email communication locally by the recipient on the recipients computer system such that the local stored Email communication is preserved even when the Email communication program deletes the single stored copy of the Email communication from the server at the time the instant invention was made.

15. It would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the method disclosed by Dillon because of similar reasons stated above. Furthermore, if the user saves the Email locally on one computer and disconnects from the network and then logs in on a different computer and deletes the Email on the server there is no way for the Email to be deleted on the first computer. Also if the user were to save the

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Email on a floppy disk and then delete the Email from the server, the server cannot delete the Email on the floppy disk, especially if the floppy disk is removed.

16. As per claim 34, as closely interpreted by the Examiner, Dillon teaches the Email communication received from the server is encrypted using a public encryption key for the one of the plurality of designated recipients, and including retrieving a private encryption key for the one of the plurality of designated recipients to decrypt the Email communication, (e.g. col. 9, line 60 – col. 10, line 15).

17. As per claim 35, as closely interpreted by the Examiner, Dillon and Arnold teach all that is similar in nature to claims 30 and 34, more specifically, Dillon teaches the acts of receiving the notification, requesting the Email communication and receiving the Email communication are performed by a receiving computer lacking sufficient permanent storage to store the Email communication, (e.g. col. 1, line 25 – col. 2, line 38 & col. 3, line 12 – 65).

18. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon and Arnold in further view of Devine et al. (6385644) (hereinafter Devine).

19. As per claim 32, as closely interpreted by the Examiner, Dillon and Arnold do not specifically teach after the receiving of the Email communication notification, storing the Email communication notification locally on the recipients computer system;

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20. after the indicating to the Email communication program to delete the Email communication, deleting the stored Email communication notification by the Email communication program, even if all recipients have not indicated to the Email communication program to delete the Email communication. Devine teaches after the receiving of the Email communication notification, storing the Email communication notification locally on the recipients computer system, (e.g. col. 12, lines 40 – 55);

21. after the indicating to the Email communication program to delete the Email communication, deleting the stored Email communication notification by the Email communication program, even if all recipients have not indicated to the Email communication program to delete the Email communication, (e.g. col. 12, lines 40 – 55). It would have been obvious to one skilled in the art at the time the invention was made to combine Devine with the combine system of Dillon and Arnold because of similar reasons stated above and further, if a user has a personal records of Email communication notifications it could prevent loss of information if the server were to break down and/or crash, (i.e. redundancy).

22. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon and Arnold and in further view of Homan et al. (6317485).

23. Referencing claim 36, as closely interpreted by the Examiner, Dillon and Arnold do not specifically teach wherein contents of the received Email communication notification are based on preferences for the one of the plurality of designated recipients, the preferences previously supplied to the server configured with the Email communication program. Homan teaches



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wherein contents of the received Email communication notification are based on preferences for the one of the plurality of designated recipients, the preferences previously supplied to the server configured with the Email communication program, (e.g. col. 6, lines 28 – 49 & col. 7, lines 1 – 44). It would have been obvious to one skilled in the art at the time the invention was made to combine Homan with the combine system of Dillon and Arnold because of similar reasons stated above and further it would be more efficient for a system to utilize a type of preference setting to classify or possibly utilize different types of Email communication notifications. This will diversify the way a user may receive notifications about incoming Email.

### ***Response to Arguments***

24. Applicant's arguments with respect to claims 30 – 36 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

26. a. Tsai U.S. Patent No. 6839741 discloses Facility for distributing and providing access to electronic mail message attachments.

27. b. Beck et al. U.S. Patent No. 5903723 discloses Method and apparatus for transmitting electronic mail attachments with attachment references.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 571-272-3912.

The examiner can normally be reached on Mon-Thur, 7:00-5:00.

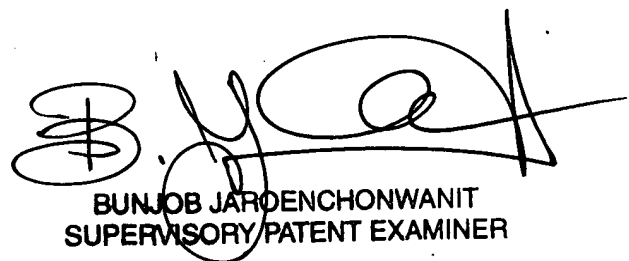
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David E. England  
Examiner  
Art Unit 2143

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